REMARKS

After entry of the foregoing amendment, claims 1-17 remain pending in the application.

Various typographical errors in the specification have been corrected by the foregoing amendment. The Examiner is thanked for his thoroughness in noting same. The specification has also been amended by updating a reference to a patent application to include the corresponding patent number.

The format of claim 16 has been amended to better comply with the indentation requirements of MPEP § 608.01(m). (Since the change is prompted by a matter of form rather than substance, it will be appreciated that no change in scope, nor surrender of equivalents, is intended.)

The rejection of claims 1 and 12 under § 101 is respectfully traversed. Method claims do not need to be embodied in computer hardware or software to be statutory. The Examiner is requested to consult with his SPE and elaborate on the basis for this rejection - if renewed - so that same can be further addressed by applicants in an appeal to the Board.

Each of the pending claims stands rejected as obvious over Shinoda (6,611,830) – either singly, or in combination with Lapstun (6,679,420). These rejections are respectfully traversed.

Shinoda is somewhat difficult to understand due to the manner of its translation from Japanese into English, but is presently understood to disclose a method for searching for web pages using digital watermark information.

In particular, Shinoda is understood to include a watermarked logo on a web page. If a user wants to find other, related, web pages, the watermark is decoded by the user's browser ("Mark Information Read Processing" in block 40143 of Fig. 4). The decoded information is then relayed to a Mark Management Server (103, Fig. 2). This server looks up the received watermark information in its Mark Management Database 2021 (see also Fig. 5) and identifies other web pages with related info (e.g., bearing the same watermarked logo). It sends the URLs of these similarly-watermarked web pages to the user's computer.

As detailed below, applicants' claims are different than the teachings of Shinoda's disclosure. And these distinctions are not redressed by the proposed combination with Lapstun.

The Action cites Shinoda at col. 4, lines 17-46, for the limitation in claim 1 *"A method of performing identifier registration comprising: establishing a connection with a registration process."* This is not believed to be an accurate statement.

The cited passage is understood to describe how Shinoda's browser loads a web page (col. 4, lines 31-32); receives a request to extract embedded information from a watermarked image on the loaded page (4:33-35); issues a request to a remote "mark management server" 103 for associated information related to the mark (i.e., for identification of other web pages bearing the same watermark, 4:35-36 and 4:45-46); and edits information obtained from server 103, and displays same on the output terminal of the user device (4:37-38).

Contrary to the statement in the Action, this does not teach "A method of performing identifier registration." Nor does this passage teach a "registration process."

Because Shinoda does not teach elements for which it has been cited, applicants respectfully submit that a *prima facie* case under § 103 has not been established.

(It will be recalled that the detailed embodiment is an identifier registration system that enables a user to request unique identifiers to be embedded in media signals. *See, e.g.,* specification, page 3, lines 2-4. Shinoda does not appear to contemplate such a system.)

Continuing..., the Action cites Shinoda at col. 5, lines 6-35, for the limitations in claim 1: *"receiving an embedder control file, including media signal identifiers and embedder instructions."*

The cited passage is understood to describe how marks are dispensed in Shinoda's system. In particular, a web page authoring system on WWW server 102 sends a request to the mark management server 103 for a mark that will be included in a web page (col. 5, lines 6-8). This request includes a mark ID, a URL of the web page, and a page name (5:9-10). The mark management server 103 loads the specified URL and displays same to an operator (5:13-16). It then displays a mark corresponding to the specified mark ID to the operator (5:16-20). If all appears to be in order, the operator authorizes the system to embed the mark ID in the requested mark image (5:20-26). The mark image with the embedded information is then transmitted back to the WWW server 102 (5:33-35).

Even if the request transmitted by the WWW server 102 to the mark management server 103 is considered to be an embedder control file, Shinoda states that this request contains "a

mark ID, a URL of the web page, and a page name" (5:9-10). Even if the "mark ID" is considered to be the claimed "media signal identifier," the claimed "embedder instructions" are nonetheless missing.

Again, due to this shortcoming of the cited art, it appears a *prima facie* case under § 103 has not been established.

Still further, while the Action next turns to consideration of the "authentication" limitation of claim 1, nothing in the Action addressed the claim limitation of *"submitting a registration request to the registration process."* This is a third shortcoming in the § 103 rejection.

The Action concedes that Shinoda is silent on the claimed authentication limitation, but proposes Lapstun to cure this deficiency. Lapstun, however, is in an entirely different field of endeavor (i.e., using business cards as electronic mail tokens). Thus, it appears the applicability of technology from Lapstun to the shortcomings of Shinoda is derived through impermissible use of hindsight, rather than a teaching or suggestion in the art. This is a fourth ground evidencing the inadequacy of the § 103 rejection.

Still further, the rationale proposed in support of the combination is deficient. The Examiner states:

> *Therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify the method of Shinoda et al to authenticate by extracting information from a watermark embedded in an identity card and providing the extracted information to the registration process as taught by Lapstun et al. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by Lapstun et al so as to interact with the computer system using a card.*

This rationale is flawed in several ways. For example, it relies repeatedly on "an identification card" (or "a card"). A card is not an element of the claimed arrangement. Moreover, the rationale refers to a "registration process" in Lapstun, although none has been cited. Still further, the combination is allegedly motivated by the ambition "to interact with the computer system using a card." However, there is no explanation why interacting with a computer system using a card has any relevance to the claimed invention. (No relevance is apparent.)

In view of such deficiencies, applicants respectfully submit that the Action has failed to meet its burden of establishing obviousness of claim 1.

Because a *prima facie* case of obviousness has not been established as to claim 1, applicants do not belabor this response by further addressing dependent claims 1-10 – which are patentable both due to their dependence on claim 1, and also separately patentable.

The rejections of independent claims 12, 16 and 17 are similarly flawed. Claim 16, for example, refers to "embedder instructions" which are not found in Shinoda. Claim 17 requires a registration server that includes an interface for receiving ID registration requests including "a list of media signal files," a "batch registration loader," and "a batch registration extractor," which are not taught by Shinoda.

The rejections of claims 16 and 17 are made on Shinoda alone. The Examiner contends:

It is apparent to one skilled in the art that the invention of Shinoda is capable of performing the steps recited in claim 16 without departing from the spirit and scope of the invention.

A similar assertion is made as to claim 17.

It will be recognized that this style of rejection does not comply with the statutory requirement. The Action must detail the shortcomings of Shinoda (i.e., why the rejection is based on obviousness rather than anticipation), and why an arrangement that includes the claim limitations not taught by Shinoda are nonetheless obvious to one skilled in the art. The rejections of claims 16 and 17 did not do this. (Moreover, the Examiner's statement, above, is simply his hindsight conclusion.)

Favorable reconsideration and passage to issuance are solicited.

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